



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address : COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

07/508,840

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
07/508,840	04/12/90	LATHROP	F 438P3195

EXAMINER
RICHARD, K

THOMAS J. WALL
WALL AND ROEHRIG
710 HILLS BUILDING
SYRACUSE, NY 13202

ART UNIT PAPER NUMBER
332 9

DATE MAILED: 09/10/91

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☒ Responsive to communication filed on 7-5-91 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 4, 6, 10, 11, 13-15, 17, 20, 21, 23-30 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☒ Claims 4, 6, 10, 11, 13, 15, 17, 20, 21, 23, 27-29 are allowed.
4. ☒ Claims 14, 24-26, 30 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

216
EXAMINER'S ACTION

Claim 14 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 14 presently depends on non-existing claim 12. In claim 14, "12" should be changed to "27".

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 24-26 are rejected under 35 U.S.C. § 103 as being unpatentable over Clarke in view of Diethelm.

Clarke discloses a housing with a battery enclosed having positive and negative terminals. Two metallic probes (o and o') extend from one side of the housing wall with possibly 3/4 to 1 and 1/2 inches between them. A conducting means (n and n') connect the positive terminal to one probe and the negative terminal to the second probe. As to claim 25, it would have been

217

obvious to one of ordinary skill in the art to make the battery of Clarke a 9 volt battery since it is a common choice in batteries and would also facilitate the placement of the positive and negative conducting wires.

Clarke does not disclose metal "caps" covering the ends of the probes nor does he disclose a specific resistor size to be used in conjunction with the battery. Diethelm teaches the use of a device for treating Herpes with two electrodes (Figure 5, items 14 and 15) as circles, representative of any proper functional structure deemed necessary to be applied at the affected dermatome. It would have been obvious to one of ordinary skill in the art to place metal caps on the probes of Clarke or to attach the probes directly on the housing wall. Clarke's probes were constructed so as to be packed inside and made portable, but different configurations would not depart from the scope of the invention as an electro therapeutic apparatus. As to claim 26, it would have further been obvious to include a 330 ohm resistor because of the DC current involved. The examiner notes that the intended use for the apparatus is not a structural claim.

Claim 30 is rejected under 35 U.S.C. § 103 as being unpatentable over Diethelm.

The Applicant's described method of stimulating, breaking, dispersing, and repeating is broad and is unpatentable over

218

Serial No. 07/508,840

-4-

Art Unit 332

Diethelm's specification. The Applicant has not defined any means for carrying out the method of treating Herpes other than repeating the "stimulating step at intervals of less than two hours." Diethelm suggests a longer "stimulating step" therefore the time between repeating the "stimulating steps" is longer than two hours. It would have been obvious to one of ordinary skill in the art to decrease the period of the stimulating step in Diethelm's methods thereby allowing one to decrease the time intervals between the steps in order to increase the amount of breaking and dispersing steps.

Claim 14 would be allowable if rewritten or amended to overcome the rejection under 35 U.S.C. § 112.

Claims 4, 6, 10, 11, 13, 15, 17, 20, 21, 23, and 27-29 are allowable over the prior art of record.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication should be directed

219

Serial No. 07/508,840

-5-

Art Unit 332

to Ms. Karen Richard at telephone number (703) 308-0858.

KR

Karen Richard
September 5, 1991



RICHARD J. APLEY
S. P. E.
ART UNIT 332

220